

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

SANDPIPER CDN, LLC,
Patent Owner

Case IPR2025-01010
U.S. Patent No. 10,057,322

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO
PATENT OWNER PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Petitioner urges “that the Board adopt the plain and ordinary meaning” of all claim terms. Paper 15 at 6. Yet, Petitioner’s new and untimely interpretations of “modified embedded resource” and “application programming interface” seek to rewrite the literal claim terms by removing limitations they allege are not found in their reading of some embodiments in the ’322 patent. *Id.* at 1-5. Petitioner further mischaracterizes Patent Owner’s arguments addressing the “tag” limitations, which apply under any reasonable construction of the term. *Id.* at 5-6. Under the ordinary meaning of each claim term, the Board should deny institution.

I. Petitioner’s new and untimely interpretation of “modified embedded resource” reads “embedded” out of the claim term.

Petitioner argues that “[t]he term ‘modified embedded resource’ should receive its plain meaning” but proceeds to read out the word “embedded” from the term completely. Paper 15 at 1-3. As the POPR explains, the claimed “modified embedded resource” is a resource embedded within another resource. POPR at 18-19. Without requiring embedding in some form, the word “embedded” would be rendered superfluous. *SimpleAir, Inc. v. Sony Ericsson Mobile Commc'ns AB*, 820 F.3d 419, 429 (Fed. Cir. 2016); *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005).

Petitioner’s new and untimely claim differentiation arguments do not alter Patent Owner’s interpretation. *First*, Petitioner argues that Patent Owner improperly reads limitations from dependent claims 12 and 13 into independent

claim 11. Paper 15 at 1-2. Not so. Claim 12 still limits claim 11 by requiring “*replacing the embedded resource* with the modified embedded resource in a resource. EX1001 at 11:10-13 (emphasis added). Claim 11 contains no such replacement requirement. Claim 13 adds that “the resource is an HTML document,” EX1001 at 11:14-16, but claim 11 is not limited to embedding within an HTML document. Thus, claims 12 and 13 properly narrow the scope of independent claim 11. *Second*, Petitioner argues that “Claim 1 introduces ‘a content resource’ ... but the other independent claims do not.” Paper 15 at 2. That claim 1 specifies a particular “content resource” does not mean the claimed “modified embedded resource” in other claims requires no embedding of any kind—that would improperly read the word “embedded” out of the claim term.

Petitioner also argues that requiring embedding “excludes disclosed embodiments” in the ’322 patent specification because, allegedly, “Figures 1 and 4 [] expressly distinguish” a “Modified ER” from a “Page with Modified ER.” Paper 15 at 2-3. But both of those embodiments still describe that the generated “modified embedded resource” as an “*embedded* resource”—whether or not embedded within an HTML page. *See, e.g.*, EX1001 at 4:67-5:4, 7:48-55.

Moreover, every embodiment cited by Petitioner involves embedding the “modified embedded resource” in another resource when it is returned to the client. *Id.* at 4:42-48 (“caus[ing] the HTML document returned to the requesting client to

include a modified embedded resource 24B with an address or URL to the CDN whereby content may be retrieved.”), 7:48-55 (“an embedded resource (referred to as the ‘modified embedded resource’) 58B to include in the page returned to the requesting client device...”). Even accepting Petitioner’s new and untimely interpretation that the “modified embedded resource” does not require the resource be embedded “during every step of the claims,” Paper 15 at 1, Petitioner fails to show that Verma’s “prepended”/“rewritten URL” is *ever* embedded—which would require reading the word “embedded” out of the claims entirely. Pet. at 22-23; POPR at 19-20; *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1257 (Fed. Cir. 2010) (“Claims must be ‘interpreted with an eye toward giving effect to all terms in the claim.’”) (internal citations omitted).

II. Petitioner also proposes an overly-broad construction of “application programming interface” based on misinterpretation of the ’322 patent.

Again, despite “request[ing] that the Board adopt the plain and ordinary meaning,” Paper 15 at 6, Petitioner untimely argues that the ordinary meaning of “API” is “irrelevant because the specification makes clear that the API can serve as the compute engine,” *id.* at 4-5. Had Petitioner wanted to propose a broader construction in view of the specification, it should have done so in its Petition. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Nevertheless, Petitioner misinterprets the ’322 patent disclosure, conflating the “API” and “compute engine” as “one and the same.” Paper 15 at 4.

Although Petitioner is correct that the '322 patent describes that “the API may include the functionality of the [computing] engine and not necessarily be considered a discrete mechanism,” EX1001, 7:22-25, the API still requires an interface that allows the client to communicate with the functions of the compute engine, in line with the ordinary meaning of “application programming interface.” POPR at 22. Indeed, the '322 patent expressly differentiates between “pass[ing] information to the computing engine” via “an API,” and “other forms of communicating with and passing information to the computing engine.” EX1001 at 7:16-22. Independent claims 11 and 15 expressly claim the former. *Id.* at 10:59-11:9, 12:5-20.

The specification’s use of “API/compute engine” and “API/compute node,” as Petitioner points out (Paper 15 at 4), further underscores that the API and computing engine are not one and the same. For example, the '322 patent describes that “[t]he API/compute engine will have access to various types of information from various possible sources.” EX1001 at 7:56-57. The patent then separately outlines the function of each: “For example, as discussed above, *the API may be passed information* and may receive information from other sources, which *information can be used by the compute engine* to generate an address...” *Id.* at 7:57-61 (emphasis added). While there is no requirement that the recited “application programming interface” and the application with which it interfaces

be discrete components, the claims still require information to be received by an “application programming interface.” EX1001, 10:59-11:9, 12:5-20; POPR at 22.

Petitioner’s interpretation raised for the first time here would effectively broaden the ordinary meaning of “API” to include any application that sends or receives information, reading out “interface.” The Board should not adopt such a broad and untimely interpretation. Under its ordinary meaning, as the POPR explains, both Verma and the Petition are silent as to how Verma’s “content broker” provides an API—as opposed to receiving information through another form of communication. POPR at 23-26.

III. Petitioner mischaracterizes Patent Owner’s arguments related to the “tag” limitation, which apply under any construction.

Petitioner alleges that “Patent Owner again injects an unclaimed ‘indicating’ requirement by contending that the ‘tag’ is ‘a tag indicating that a resource address compute engine 30 should be contacted via a call to an API 26.’” Paper 15 at 5 (citing POPR at 28). Not true—Patent Owner does not propose importing any such limitation into the claims. POPR at 26-31.

Petitioner’s “claim construction” diversion mischaracterizes the arguments presented in the POPR. In particular, the POPR argues, “claim 1 requires that the recited ‘tag’ be used to initiate the operation of obtaining ‘the modified embedded resource [that] includes a direct link to a node within the content delivery network that can deliver content associated with the embedded resource.’” POPR, 28-29

(citing EX1001, 10:6-18). But “Lewin’s purported ‘tag,’ in contrast to the ‘tag’ recited in claim 1 of the ’322 patent, is not used to obtain a ‘modified embedded resource *[that] includes a direct link to a node within the content delivery network that can deliver content associated with the embedded resource,*’ as required by claim 1.” POPR, 29 (emphasis added).

In other words, Patent Owner argues that the purported “tag” in the Verma-Lewin combination does not satisfy the limitations of claim 1 because it is not used to obtain the recited “modified embedded resource *[that] includes a direct link to a node within the content delivery network that can deliver content associated with the embedded resource,*” as expressly required by claim 1. EX1001, 10:5-18. Verma-Lewin’s purported “tag” is used to add content to a page—not to obtain a “direct link to a node” that can serve the content, as required by the claim. *Id.*; POPR at 29-30; Pet. at 47-48. Patent Owner’s arguments are divorced from any particular meaning of “tag”—they apply under *any* reasonable interpretation of the term, including Petitioner’s newly asserted interpretation not found in the Petition.

IV. Conclusion

For the reasons set forth above and in Patent Owner’s Preliminary Response, the Board should deny institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO PATENT OWNER PRELIMINARY
RESPONSE** was served in its entirety on October 24, 2025, upon the following
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